



THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of

Confirmation No.: 7751

SEYDOUX

Atty. Ref.: 677-38

Serial No. 10/585,866

Group: 2173

Filed: July 11, 2006

Examiner: D. Bonshock

For: A VOICE INTERFACE FOR FINDING AND SELECTING AN
OPTION, IN PARTICULAR FOR A MOBILE TELEPHONE ON BOARD A
VEHICLE

* * * * *

APPEAL BRIEF

On Appeal From Group Art Unit 2173

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September 24, 2010

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

I. REAL PARTY IN INTEREST

The real party in interest in the above-identified appeal is Parrot Societe
Anonyme by virtue of an assignment of rights from the inventor to Parrot Societe
Anonyme recorded March 11, 2009 at Reel 22398, Frame 246.

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II. RELATED APPEALS AND INTERFERENCES

There are believed to be no related appeals, interferences or judicial proceedings with respect to the present application, other than the Pre-Appeal Brief Request for Review previously filed in this application on July 14, 2010.

III. STATUS OF CLAIMS

Claims 1-8 stand finally rejected under 35 USC §103. Specifically, claims 1-6 stand rejected as being obvious over Potter (U.S. Patent 5,555,172), Zeinstra (U.S. Patent 4,827,520) and Weinper (U.S. Pub. 2003/0074112). Claims 7 and 8 stand rejected under 35 USC §103 over Potter in view of Zeinstra. The above rejections of claims 1-8 are appealed.

IV. STATUS OF AMENDMENTS

No further response has been submitted with respect to the Final Official Action in this application other than the filing of a Pre-Appeal Brief Request for Review which decision was mailed August 24, 2010.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Appellant's specification and figures provide an explanation of the claimed invention set out in independent claims 1, 7 and 8, with each claimed structure and method step addressed as to its location in the specification and in the figures.

"1. A device [device 10 as shown in Figure 1 and discussed on page 4, line 20 to page 5, line 14 and elsewhere in the specification] forming an interface for finding and selecting an option in a hierarchical directory, in particular for searching for and selecting a number in a directory of a mobile telephone on board a vehicle, the device comprising:

- a data memory [circuit 22 as shown in Figure 2 and discussed on page 4, lines 27-33 and page 5, lines 4-14 and elsewhere in the specification] containing a plurality of said options ordered as a sequential list;
- a pointer [knob 14 when pushed as per 28 as shown in Figure 2 and discussed on page 4, lines 30-33 and elsewhere in the specification] for selecting one of the options of the list;
- selector means [knob 14 when rotated as per 26 as shown in Figure 2 and discussed on page 4, lines 30-33 and elsewhere in the specification] for incrementing or decrementing the pointer in response to controlled manipulation by a user; and
- processor means [mobile phone processor 30 as shown in Figure 2 and discussed on page 5, lines 10-14 and paragraph bridging pages 5-6 and elsewhere in the specification] for executing a set of predetermined actions as a function of the options in the data memory;
- acoustic means [transducer 20 as shown in Figure 2 and discussed on page 4, lines 20-26 and page 6, lines 5-17 and elsewhere in the specification] for

sending to the user an audible message comprising a voiced representation of the option selected by the pointer in response to said pointer being incremented or decremented; and

· confirmation means, manipulated by the user, for reading the option selected by the pointer [display 12 as shown in Figure 2 and discussed on page 4, lines 20-26 and page 6, lines 26-30 and elsewhere in the specification] and transferring said option to the processor means for executing the corresponding action [mobile phone processor 30], wherein said selector means comprises a two-directional rotary knob [14] that can be manipulated by the user, and said confirmation means comprising a transient contact that can be actuated by pressing on said rotary knob [14 as shown in Figure 2 and discussed on page 7, lines 33-36 and elsewhere in the specification].”

“7. A device [device 10 as shown in Figure 1 and discussed on page 4, line 20 to page 5, line 14 and elsewhere in the specification] for providing a user an audible indication of a chosen option, said device comprising:

a data memory storing a plurality of options [circuit 22 as shown in Figure 2 and discussed on page 4, lines 27-33 and page 5, lines 4-14 and elsewhere in the specification];

a pointer [knob 14 when pushed as per 28 as shown in Figure 2 and discussed on page 4, lines 30-33 and elsewhere in the specification] manipulated

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by said user [direction 26 shown in Figure 2 and discussed on page 4, lines 30-33 and elsewhere in the specification] to indicate one of said options;

an acoustic transducer [transducer 20 as shown in Figure 2 and discussed on page 4, lines 20-26 and page 6, lines 5-17 and elsewhere in the specification], responsive to the indication of one of said options, providing a voiced representation of the indicated option; and

a user activated switch [direction 28 shown in Figure 2 and discussed on page 4, lines 30-33 and elsewhere in the specification] for implementing said indicated option.”

“8. A method of providing a user an audible indication of a chosen option among a plurality of options stored in a data memory, said method comprising the steps of:

 said user manipulating a pointer to indicate one of said plurality of options [steps 32 & 34 as shown in Figure 3 and as discussed on page 5, line 35 to page 6, line 4 and elsewhere in the specification];

 providing said user with a voiced representation of each indicated option [steps 48 & 58 as shown in Figure 3 and as discussed on page 6, lines 5-17 and elsewhere in the specification]; and

said user selecting, based upon said voiced representation of a chosen option, said chosen option with an electronic input [step 66 as shown in Figure 3 and as discussed on page 7, lines 33-36 and elsewhere in the specification]."

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-6 stand rejected under 35 USC §103 as unpatentable over Potter (U.S. Patent 5,555,172), Zeinstra (U.S. Patent 4,827,520) and Weinper (U.S. Pub. 2003/0074112).

Claims 7 and 8 stand rejected under 35 USC §103 as unpatentable over Potter and Zeinstra.

VII. ARGUMENT

Appellant's arguments include the fact that the burden is on the Examiner to first and foremost properly construe the language of the claims to determine what structure and/or method steps are covered by that claim. After proper construction of the claim language, the burden is also on the Examiner to demonstrate where in the plurality of combined references (in the case of an obviousness rejection) there is taught each of the structures and/or method steps recited in independent claims 1, 7 and 8.

Furthermore, the Court of Appeals for the Federal Circuit has stated in the case of *In re Rouffet*, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998)

to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court **requires** the examiner to show a **motivation** to combine the references that create the case of obviousness. In other words, the Examiner **must show reasons** that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. (Emphasis added).

In its recent decision, the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (April 2007), held that it is often necessary for a court to look to interrelated teachings of multiple patents, the effects of demands known to the design community or present in the marketplace and the background knowledge possessed by a person of ordinary skill in the art in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. The Supreme Court held that “[t]o facilitate review, this analysis should be made explicit.” *Id.* at 1396.

The Supreme Court in its *KSR* decision went on to say that it followed the Court of Appeals for the Federal Circuit’s advice that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (the Supreme Court quoting from the Court of Appeals for the Federal Circuit in *In re Kahn*, 78 USPQ2d 1329 (Fed. Cir. 2006)).

A. The Examiner fails to properly construe Appellant's independent claims as required by 35 USC §112 (6th paragraph)

Independent claims 1, 7 and 8 recite "means-plus-function" and "step-plus-function" format recitations for structural elements and method steps. In accordance with the 6th paragraph of §112, the Examiner is obligated to construe these portions of the claim to cover the corresponding structure and steps disclosed in Applicant's specification and equivalents thereof.

Using claim 1 for example (although the argument is similarly applicable to apparatus claim 7 and method claim 8), the claim requires "acoustic means for sending to the user an audible message comprising a voiced representation of the option selected by the pointer." Appellant's specification in the paragraph bridging pages 5 and 6 and the first full paragraph on page 6, describe at least one embodiment of the present invention in which the "acoustic means" includes a voice synthesis which is a voiced representation of an option chosen by the operator's movement of a pointer.

Under §112 the Examiner is obligated to construe the acoustic means of claim 1 and the acoustic step of claim 8 to be directed to such structure and such sequence of method steps, respectively, and "equivalents thereof." There appears to be nothing in the Final Rejection either acknowledging that claims are in "means-plus-function" or "step-plus-function" format, or properly construing these "means-

plus-function” or “step-plus-function” claims as requiring the corresponding structures or steps disclosed in the specification.

The Examiner’s failure to properly construe means-plus-function and step-plus-function claims is reversible error.

B. The Examiner fails to identify any prior art reference disclosing any structure falling within the scope of the properly construed “acoustic means” in claim 1 (and similar structure and method step in claims 7 and 8) or its claimed structural interrelationship

The Examiner alleges in section 5, and particularly the partial paragraph on page 4 of the Final Rejection, that the claimed “acoustic means” is disclosed in Potter. However, the cited portion of Potter at column 10, lines 10-56, contains no such teaching.

Further, in paragraph 6 on page 4 of the Final Rejection, the Examiner specifically admits that Potter “doesn’t specifically teach acoustic means suitable for sending to the user an audible message constituting a voiced representation of the option selected by the pointer.” This admission is very much appreciated and contradicts the Examiner’s allegation that Potter at column 10, lines 10-56 provides such a disclosure. : :

Moreover, Appellant can find no such indication of anything covered by Appellant’s claimed “acoustic means” (as properly construed) in the Potter reference.

In the sentence bridging pages 4 and 5 of the Final Rejection, the Examiner alleges that Zeinstra teaches the missing “acoustic means.” However, the portion of Zeinstra cited at columns 7 and 14 merely teach a voice actuated control system for use in a vehicle. It is the user’s voice which provides the voice actuation.

There is no “audible message” which is sent back to the user in the manner of the currently claimed “acoustic means.” There is no suggestion that Weimper contains any disclosure of a structure which the Examiner concludes falls within the scope of an “acoustic means.”

Not only does the Examiner fail to indicate that the properly construed “acoustic means” is disclosed somewhere in the prior art, but he fails to indicate any prior art reference which provides the claimed interrelationship, i.e., “an audible message comprising a voiced representation of the option selected by the pointer.” Further, this structure is not even alleged by the Examiner to be shown in a prior art reference.

With respect to both the structure and the interrelationship between structures as noted above, the Examiner is challenged to identify in the Examiner’s Answer, any disclosure of such structure and such interrelationship between structures in any of the prior art references.

Absent such disclosure, the Examiner has failed to meet his burden of identifying evidence which discloses Appellant’s claimed “acoustic means” and its interrelationship when this term is properly construed in accordance with 35 USC

§112. The failure to identify any prior art to disclose claimed subject matter is reversible error on the Examiner's part.

C. The Examiner fails to meet his burden of setting evidence establishing a *prima facie* case of obviousness because no cited reference discloses the claimed "acoustic means"

As noted above, the Examiner has failed to identify any teaching in the Potter, Zeinstra or Weimper references which comprise the claimed "acoustic means" in claim 1 (or the corresponding structure and method step in claims 7 and 8) or the claimed interrelationship.

It is well settled that "the PTO has the burden under §103 to establish a *prima facie* case of obviousness." *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Court has held that the PTO "can satisfy this burden only by showing some objective teaching in the prior art . . ." Here, the Examiner has identified no teaching in any cited prior art reference of the claimed "acoustic means" and no teaching of the claimed interrelationship of "sending to the user an audible message comprising a voiced representation of the option selected by the pointer . . ." (emphasis added). Therefore, the combination of all references fails to disclose at least two features of Appellant's independent claims.

The Examiner's failure to meet his burden of setting out a *prima facie* case of obviousness under 35 USC §103 is reversible error.

D. The Examiner fails to set out a *prima facie* case of obviousness because there is no required “analysis” of the Examiner’s reasons for combining references

In order to meet the second requirement of a *prima facie* case of obviousness, the U.S. Supreme Court has recently clarified the Examiner’s obligations. In *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (April 2007), it was held that it is often necessary for a court to look to interrelated teachings of multiple patents, the effects of demands known to the design community or present in the marketplace and the background knowledge possessed by a person of ordinary skill in the art in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. The Supreme Court held that “[t]o facilitate review, this analysis should be made explicit.” (emphasis added) *Id.* at 1396.

The Supreme Court went on to say that it followed the Court of Appeals for the Federal Circuit’s advice that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” ((emphasis added) the Supreme Court quoting from the Court of Appeals for the Federal Circuit in *In re Kahn*, 78 USPQ2d 1329 (Fed. Cir. 2006)).

The only statement made by the Examiner which purportedly meets his obligation is the allegation that it would be “obvious to one of ordinary skill in the

art . . . to modify vehicular telecommunication system control of Potter to include the verbal confirmation as did Zeinstra.” (Page 5, lines 2-5). However, this is a conclusory statement and has nothing to do with Appellant’s “acoustic means” nor does it suggest that either of the two references provide any audible “representation of the option selected” by a pointer.

The Examiner apparently concludes that one would be motivated to combine the two references because this “allows for a intuitive [sic]/hands free [sic] method for the user to confirm selection without taking their eyes off the road.” (Page 5, lines 6-8). However, as noted above, in the Potter system one must look at a display. In Zeinstra, and typical of voice command systems, one must request confirmation of an original voice command. Appellant’s claimed “acoustic means” does not utilize a voice command initially, but rather, a user manipulated selector and then provides “**a voiced representation of the option selected.**” While Zeinstra clearly does provide a voice output in response to an audible input, it does not provide a voice output in response to a manual input as set out in Appellant’s claims. Thus, even the Examiner’s motivation with respect to combining the Potter and Zeinstra references is faulty. The Examiner provides merely a conclusory statement which, as noted by the Supreme Court, is insufficient rationale for basing an obviousness rejection.

In view of the above, the Examiner fails to meet either of the tests of a *prima facie* case of obviousness and thus the burden remains with the Examiner to

prove some basis for rejecting Appellant's claims 1-6. The Examiner has failed to meet his burden of proof under §103 and therefore claims 1-6 are clearly patentable over the Potter/Zeinstra/Weimper combination.

E. The Examiner fails to meet his burden of establishing a *prima facie* case of obviousness with respect to claims 1-6

As noted above in argument A, the Examiner does not appear to have properly construed Appellant's independent claims as required by 35 USC §112 (6th paragraph). Without proper claim construction, the Examiner's obviousness analysis fails because it does not identify what is being claimed and therefore what must be shown as being obvious in the cited prior art references.

The Examiner fails to indicate where the prior art discloses the claimed "acoustic means" as noted in Argument B above. As noted in Argument C, since all claims elements are not identified by the Examiner as being disclosed in the combination of references to Potter, Zeinstra and Weimper, the Examiner has failed to meet his burden of identifying evidence that each of the claimed structures and/or method steps is disclosed in the prior art combination.

Moreover, as set out in argument D above, the Examiner fails to meet his burden of establishing the Supreme Court required "analysis" of the Examiner's reasons for combining references. The Examiner merely provides conclusory statements and identifies no evidence or rationale by which portions of such

references would be combined with each other in the manner of Appellant's claims.

In view of the above, the Examiner fails to meet his burden of proof with respect to either of the two tests of a *prima facie* case of obviousness, i.e., each claimed elements or claimed method step is disclosed somewhere in the combination of references and the second burden of proof in identifying some rationale for selecting elements or method steps from the various references and then combining them in a manner disclosed only in Appellant's claims.

As a result of the above, the Examiner's rejection of claims 1-6 is unsupported and does not rise to the level of a *prima facie* case of obviousness.

F. The Examiner fails to meet his burden of establishing a *prima facie* case of obviousness with respect to claims 7 and 8

As noted above in argument A, the Examiner does not appear to have properly construed Appellant's independent claims as required by 35 USC §112 (6th paragraph). Without proper claim construction, the Examiner's obviousness analysis fails because it does not identify what is being claimed and therefore what must be shown as being obvious in the cited prior art references.

The Examiner fails to indicate where the prior art discloses the claimed "acoustic transducer, . . . , providing a voiced representation of the indicated

option" (in claim 7) or the "providing said user with a voiced representation of each indicated option" (claim 8) as noted in Argument B above.

As noted in Argument C, since all claims elements are not identified by the Examiner as being disclosed in the combination of references to Potter & Zeinstra, the Examiner has failed to meet his burden of identifying evidence that each of the claimed structures and/or method steps is disclosed in the prior art combination.

Moreover, as set out in argument D above, the Examiner fails to meet his burden of establishing the Supreme Court required "analysis" of the Examiner's reasons for combining references. The Examiner merely provides conclusory statements and identifies no evidence or rationale by which portions of such references would be combined with each other in the manner of Appellant's claims.

In view of the above, the Examiner fails to meet his burden of proof with respect to either of the two tests of a *prima facie* case of obviousness, i.e., the first prong of obviousness, i.e., each claimed element or claimed method step is disclosed somewhere in the combination of references and the second prong of obviousness in identifying some rationale for selecting elements or method steps from the various references and then combining them in a manner disclosed only in Appellant's claims.

As a result of the above, the Examiner's rejection of claims 7-8 is unsupported and does not rise to the level of a *prima facie* case of obviousness.

VIII. CONCLUSION

In the present application, the Examiner has failed to properly construe the means-plus-function and step-plus-function language contained in Appellant's independent claims. Even if that language were properly construed, the Examiner fails to identify in at least one prior art reference structure which he believes corresponds to Applicant's claimed "acoustic means" or the corresponding method step. Accordingly, even if all references were combined, there can be no *prima facie* case of obviousness.

Furthermore, according to the Supreme Court, the Examiner is not permitted to willy-nilly pick and choose bits and pieces of various references and then combine them in the manner of Appellant's claims. The Examiner fails to meet the Supreme Court standard of setting out a rational "analysis" as to his reasons for combining portions of references in the manner of Appellant's claims. This failure also eliminates the possibility of a *prima facie* case of obviousness.

As a result of the above, there is simply no support for the rejections of Applicants' independent claims or claims dependent thereon under 35 USC §103. Thus, and in view of the above, the rejection of claims 1-8 under 35 USC §103 is clearly in error and reversal thereof by this Honorable Board is respectfully requested.

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Serial No. 10/585,866

Respectfully submitted,

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By: 

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SCS:kmm
Enclosure

IX. CLAIMS APPENDIX

1. A device forming an interface for finding and selecting an option in a hierarchical directory, in particular for searching for and selecting a number in a directory of a mobile telephone on board a vehicle, the device comprising:
 - a data memory containing a plurality of said options ordered as a sequential list;
 - a pointer for selecting one of the options of the list;
 - selector means for incrementing or decrementing the pointer in response to controlled manipulation by a user; and
 - processor means for executing a set of predetermined actions as a function of the options in the data memory;
 - acoustic means for sending to the user an audible message comprising a voiced representation of the option selected by the pointer in response to said pointer being incremented or decremented; and
 - confirmation means, manipulated by the user, for reading the option selected by the pointer and transferring said option to the processor means for executing the corresponding action, wherein said selector means comprises a two-directional rotary knob that can be manipulated by the user, and said confirmation means comprising a transient contact that can be actuated by pressing on said rotary knob.

2. The device of claim 1, further comprising display means for displaying the option selected by the pointer.

3. The device of claim 2, in which the display means also display at least one of the preceding and/or following options in the list.

4. The device of claim 1, in which:

- said options contain names;
- a telephone number is associated with each option; and
- the action executed by the processor means is dialing the corresponding telephone number.

5. The device of claim 4, in which:

- said options contain letters of the alphabet; and
- the action executed by the processor means is positioning the pointer on the first name beginning by the selected letter.

6. The device of claim 1, in which:

- said options contain command menu titles, or the titles of lower-level menus; and

the action executed by the processor means is to execute the corresponding command or to select the corresponding lower-level menu.

7. A device for providing a user an audible indication of a chosen option, said device comprising:

a data memory storing a plurality of options;
a pointer manipulated by said user to indicate one of said options;
an acoustic transducer, responsive to the indication of one of said options, providing a voiced representation of the indicated option; and
a user activated switch for implementing said indicated option.

8. A method of providing a user an audible indication of a chosen option among a plurality of options stored in a data memory, said method comprising the steps of:

said user manipulating a pointer to indicate one of said plurality of options;
providing said user with a voiced representation of each indicated option;
and
said user selecting, based upon said voiced representation of a chosen option, said chosen option with an electronic input.

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X. EVIDENCE APPENDIX

None.

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XI. RELATED PROCEEDINGS APPENDIX

None.